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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/410,494	09/30/1999	KURT W. PIERSOL	74451.P107	6948

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EXAMINER

WON, YOUNG N

ART UNIT PAPER NUMBER

2155

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Cg

Office Action Summary

Application No.

09/410,494

Applicant(s)

PIERSOL ET AL.

Examiner

Young N Won

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

1. Claims 1-34 have been examined.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Fig. 2C, reference no.272. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: Page 20 line 12: "440" should be 540.

Appropriate correction is required.

Claim Objections

3. Claim 28 is objected to because of the following informalities: There is no claim 28. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-8, 12-20, 24-27, and 29-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Walls et al. (U.S. Pat. No.5848410).

As per claims 1 and 13, Walls teaches a method (see col.8 lines 5: system and method) comprising and a machine-readable medium having stored thereon sequences of instructions that, when executed by one or more processors (see col.9 lines 39-51), cause: generating, automatically (see col.8 lines 10-11) with an electronic system (see col.9 line 35: network environment and Fig.1), a first search request (see col.26 lines 25-26: search one or more files...at one or more intervals) in response to an original search request, the first search request to cause a search to be performed on electronic

documents (see col.1 lines 39-42 and col.3 lines 17-18: web page) unconsciously captured (see col.12 lines 57-67 to col.13 lines 1-4) by a local network device (see col.10 lines 15-16: output devices), the search of the electronic documents unconsciously captured to be performed according to search parameters of the original search request (see col.11 lines 25-39); and generating, automatically with the electronic system, a second search (see col.26 lines 25-26: search one or more files... at one or more intervals) request in response to the original search request, the second search request to cause a search to be performed on electronic documents available via a network portal (see col.10 lines 23 & 36: network interface) of an external network (see col.1 lines 26-29: Internet) according to the search parameters of the original search request.

As per claims 2 and 14, Walls further teaches wherein the local network device comprises a file management appliance (see col.3 lines 52-55: continuous indexer).

As per claims 3 and 15, Walls further teaches wherein the file management appliance generates the first search request and the second search request (see col.3 lines 64-67: at least, to col.4 lines 1-2, and col.11 lines 23-25 & 35-39).

As per claims 4 and 16, Walls further teaches wherein the file management appliance performs a search of the unconsciously captured electronic documents in response to the first search request (see col.12 lines 57-67 to col.13 lines 1-4).

As per claims 5 and 17, Walls further teaches an Internet portal (see col.10 line 40: Internet, and Fig.1 no.150) performs a search of the electronic documents available

via a network portal 9 see col.10 lines 23 & 36: network interface, and Fig.1 no.128) of an external network in response to the second search request.

As per claims 6 and 18, Walls further teaches wherein the first search request, and the second search request, are generated by a portal appliance (see col.3 lines 52-55: continuous indexer) in response to the original search request.

As per claims 7 and 19, Walls further teaches generating a search report based on results from the first search request and the second search request (see. Col5 lines 49-52).

As per claims 8 and 20, Walls further teaches wherein the search report is a Hypertext Markup Language (HTML) document (see col.1 lines 29-32 & 59-62, col.4 lines 23-24, and col.12 lines 29-30).

As per claims 12 and 24, Walls further teaches generating a third search request in response to the original search request, the third search request (see col.26 lines 25-26: search one or more files...at one or more intervals) to cause a search to be performed on electronic documents available via a second network portal (see col.10 lines 37-39, nodes may consist of more host servers, whereby in lines 35-36, include via a network interface) of the external network according to the search parameters of the original search request.

As per claim 25, Walls teaches of an apparatus comprising: a device (see col.10 lines10-14) to automatically (see col.8 lines 10-11) capture electronic documents from the network (see col.4 lines 20-21); and an application (see col.9 lines 39-51) to search the captured electronic documents (see col.1 lines 39-42 and col.3 lines17-18: web

page) in response to a search request, wherein the application also generates an external document search request (see col.11 lines 57-61) in response to the search request, the external document search request to generate a search of electronic documents from an external network (see col.1 lines 26-29: Internet).

As per claim 26, Walls further teaches that the application is executed by the device (see col.9 lines 39-43).

As per claims 27 and 29, Walls further teaches that the application is executed by a second device coupled to the device wherein the search of captured electronic documents is performed by the second device (see col.10 lines 24-34).

As per claims 30 and 31, Walls further teaches that external document search is performed by an Internet portal (see col.10 line 40: Internet, and Fig.1 no.150) wherein the search of captured electronic documents is performed by the device (see col.10 lines 24-34).

As per claim 32, 33, and 34, Walls teaches of a method and apparatus (see col.8 line 5) comprising, and a machine readable medium having stored thereon sequences of instructions (see col.9 lines 39-51) that, when executed by one or more processors, cause one or more electronic devices to: generating a search request to retrieve predetermined information (see col.4 lines 30-31) from a network portal (see col.10 lines 23 & 36: network interface) at one or more predetermined times (col.4 line 41-42); capturing, unconsciously (see col.12 lines 57-67 to col.13 lines 1-4), the predetermined information in response to the predetermined information being retrieved; and archiving the captured predetermined information (see col.5 lines 51-52 and col.20 lines 61-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walls et al. (U.S. Pat. No.5848410) as applied to claims 1, 7, 13, and 19 above, and further in view of MacKenty et al. (U.S. Pat. No.6088675). Walls teaches all the limitations of claims 9 and 21, except that the search report is an Extensible Markup Language (XML) document. MacKenty teaches that a report can be an Extensible Markup Language (XML) document (see col.1 lines 19-21). It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to employ the teaching of MacKenty within the system of Walls, by using XML documents within the search report, because XML documents are used for technical documentations. Thus, if technical searches were widely performed, one would employ an XML document as the standard.

6. Claims 10, 11, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walls et al. (U.S. Pat. No.5848410) as applied to claims 1, 7, 13, and 19 above, and further in view of Rakavy et al. (U.S. Pat. No.5913040). Walls teaches

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all the limitations of claims 10, 11, 22, and 23, except that the search report comprises an advertisement selected based on the first search request and based on analysis of documents indicated by search results. Rakevy teaches of a search report comprises an advertisement selected based on the first search request and based on analysis of documents indicated by search results (see col.1 lines 20-22 & 35-42). It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to employ the teaching of Rakevy within the system of Walls, by employing search reports comprising an advertisement generated from search results, because this would allow searching systems like Walls' to generate revenue from companies who wish to advertise to customers using such systems, in similar fashion to web site advertising methods currently employed.

Conclusion

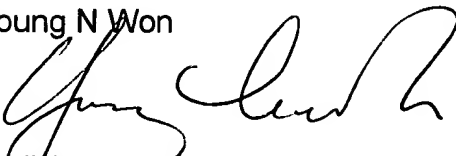
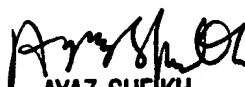
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-F: 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3718 for regular communications and 703-305-5352 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Young N Won


April 28, 2002
AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100